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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,751	09/15/2003	James D. Goss	7784-000641	1549

7590 08/03/2006

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EXAMINER
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KRAUSE, JUSTIN MITCHELL

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/662,751

Applicant(s)

GOSS ET AL.

Examiner

Justin Krause

Art Unit

3682

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 17-25 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16, 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of claims 8-16 drawn to a Bearing Assembly in the reply filed on May 16, 2006 is acknowledged. The traversal is on the ground(s) that no serious burden arises from examining the entire application. This is not found persuasive because the examiner finds that it would be a serious burden to examine all of the claimed inventions in the application.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-7, 17-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 16, 2006. Examiner further withdraws new claim 36 as being dependent on withdrawn claim 1.

Claims 8-16 and 26-35 are currently pending.

***Information Disclosure Statement***

3. The Information Disclosure Statement filed November 21, 2003 has been considered.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "bearing cups" and "the second bearing cup" and there is insufficient antecedent basis for multiple bearing cups as claim 8, from which claim 10 depends only recites a single cup.

Throughout claims 10-13 and 15, repeated reference is made to limitations in pluralities (i.e. teeth, slots, bearings, etc...) which would not satisfy the preceding limitation "at least one" because if there were only one, the feature would not be plural.

It appears as applicant's intent is for claim 10 to depend from claim 9, as claim 9 recites a second bearing cup which would make the references to plural entities definite. For purposes of examination, the Examiner is treating claim 10 as being dependent on claim 9 in order to treat claims 10-15 on the merits as best as is understandable.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-16 and 26-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Baninger (US Patent 1,851,561).

Baninger discloses a bearing assembly comprising:

- a first inner race (68) and a first outer race (80)
- a first bearing cup (84) secured to the first outer race, including a projecting structural element (90) and a plurality of teeth (88)
- a plurality of first rolling elements disposed between the first inner and outer races (76)
- a second inner race (70) and a second outer race (82)
- a second bearing cup (86) secured to the second outer race and including a plurality of teeth (88)
- a second plurality of rolling elements (78) disposed between the second inner and outer races.

Regarding the limitation that the projecting structural element prevents rotation while allowing for axial movement of the first bearing cup and the teeth of the first and second bearing cups engage to prevent relative rotation; the device of Baninger meets these limitations (see page 2 lines 45-55) however functional limitations are being given limited patentable weight and the device must be defined over the prior art by its structure, and not its function.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)

"[A]pparatus claims cover what a device is, not what a device does."

*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). (see MPEP 2114)

The bearing assembly further comprises a spring (100, 102) disposed axially between the first outer race and the second outer race.

The first bearing cup includes a plurality of circumferentially arranged slots around a perimeter portion for engaging with the teeth of the second bearing cup and visa versa.

The bearing cups include shoulders (96) extending radially inward from an inner surface, the shoulders abut the outer races.

A shim (72) is disposed between the inner races.

Regarding claim 16, product by process limitations are given minimal patentable weight in device claims.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (See MPEP 2113 [R-1])

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK  
8/1/06

  
RICHARD RIDLEY  
SUPERVISORY PATENT EXAMINER